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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,305	11/17/2003	Marten Dwight Marshall		5114
7590 06/13/2005				
Marten Marshall PO Box 372 Sunset Beach, CA 90742-0372				
		EXAMINER COLILLA, DANIEL JAMES		
		ART UNIT 2854		
		PAPER NUMBER		

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,305

Applicant(s)

MARSHALL, MARTEN DWIGHT

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 8-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/17/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 8-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 3/24/05.

Claim Objections

2. Claims 2-3 are objected to because of the following informalities:

In claim 2, the terms, “a second, top layer” and “a first, bottom layer” are double recitations of that which has already been recited in claim 1. This objection could be overcome by reciting --the-- or --said-- top and bottom layers thus indicating that applicant is referring to the same structures that have previously been recited.

In claim 3, the “a previous layer” appears to be a double recitation of “a first, bottom layer” recited in claim 1. This objection could be overcome by replacing “a previous layer” with --the bottom layer-- or --said bottom layer--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 4-7, applicant recites a middle layer between the top and bottom layers. However, the parent claim, claim 1, recites that the top layer is printed *directly* on top of the bottom layer. The use of the term “directly” is interpreted to mean that the top and bottom layers touch one another and there are no intervening layers. Since a dependent claim inherently includes all the limitations of the parent claim, claims 4-7 improperly negate the “directly” limitation by reciting that the middle layers are between the top and bottom layer.

For purposes of applying the most relevant prior art and expediting the prosecution of the application, claims 4-7 will be interpreted as not containing the conflicting “directly” limitation. This would appear to be applicant’s intention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Sodeyama (JP 2001-010298).

With respect to claim 1, Sodeyama discloses a method for creating a picture having two sides including the steps of printing a first, bottom layer 2 directly onto a transparent medium 1 and printing a second, top layer 3 directly on top of the bottom layer 2 as shown in Figures 1-3 of Sodeyama and disclosed in the first sentence of the “Solution” portion of the English abstract.

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With respect to claim 2, Figures 1-2 of Sodeyama show that the top layer is printed precisely on top of the first, bottom layer.

With respect to claim 3, Figures 1-2 of Sodeyama show that the top layer is printed precisely on top of a previous layer (the first, bottom layer). Sodeyama discloses that a first image (an uncut watermelon) is shown in when the substrate 1 is viewed from one side, as shown in Figure 1, and a second image (a cut watermelon) is shown when the substrate is viewed from the back side, as shown in Figure 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 -7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sagi (US 6,142,620).

With respect to claim 4, Sagi discloses the claimed method for creating a picture having two sides except for the multiplicity of white layers. Sagi discloses printing a first, bottom layer 61 directly onto a transparent medium 60, printing a middle white layer 62 (Sagi, col. 4, lines 52-56) and printing a second, top layer 63 such that the middle white layer 62 is sandwiched between the top and bottom layer as shown in Figure 5 of Sagi. It has been held that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced (see MPEP§ 2144.04, part VI, B). In this instance, there has been no unexpected result

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disclosed regarding the multiplicity of white layers. It would have been obvious to use a multiplicity of white layers in order to increase the blocking power of the white and prevent any of the image from the other side from showing through.

With respect to claim 5, Sagi discloses the claimed method as mentioned above with respect to claim 4 and further discloses that the middle layer 62 is precisely over the bottom layer 61 such that the middle layer 62 covers the bottom layer 61 as shown in Figure 5 of Sagi. Note the term "precisely" is a comparative term with no basis of comparison in the claim, thus it is being interpreted to mean that the layers are aligned.

With respect to claim 6, Sagi discloses the claimed method as mentioned above with respect to claims 4 and 5 and further discloses that the middle layer 62 underlies said top layer 63 as shown in Figure 5 of Sagi.

With respect to claim 7, Sagi discloses the claimed method as mentioned above with respect to claims 4-6 and further discloses that the middle layer 62 is precisely over the bottom layer 61 and precisely beneath the top layer 63.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hicks, Kroner and Kondo are cited to show other examples of a method of printing a picture having two sides. Blake et al. and Sugawara are cited to show examples of a method of printing a picture including a white layer between top and bottom printed layers.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 9, 2005



Daniel J. Colilla
Primary Examiner
Art Unit 2854